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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Where application of : MATEEN JAMIL GREENWAY
U.S. Serial No. : 10/732,977
Filed : December 11, 2003
For : SYSTEM, METHOD, AND COMPUTER PROGRAM
PRODUCT FOR NETWORK-BASED COMMON OPERATING
ENVIRONMENT WITH USER-SELECTABLE SERVICES AND
BILLING
Art Unit : 3625
Examiner : Adam L. Levine

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. The review is requested for the reason(s) stated in the arguments below, demonstrating the clear legal and factual deficiency of the rejections of some or all claims.

Claims 1-21 were rejected under 35 U.S.C. §102(e) as being anticipated by *Teper et al.* (U.S. Patent No. 5,815,665, hereinafter *Teper*). For the convenience of the panel, claim 1 is reproduced below:

1. A method for providing data processing services, comprising:
 - sending a list of available services to be displayed to a user, the list of available services including pricing information for at least some available services;
 - receiving a user selection of a service;
 - providing the selected service to the user;
 - creating a billing record indicating the selected service and the user; and
 - storing the user selection, wherein the services are provided within an enterprise common operating environment.

Independent claim 1 requires, among other limitations, that the services are provided within an enterprise common operating environment. Independent claims 8 and 15 include similar limitations. These limitations are not taught or suggested by *Teper*.

Teper does disclose a system that appears to centrally manage billing and authorization (collectively, “brokering”) for various service providers (SPs). However, *Teper* teaches in column 4 that each of the services are actually provided by different, individual web sites, and not in an enterprise common operating environment, as described and claimed in the present application. In fact, this teaching of *Teper* is directly away from an enterprise common operating environment.

The Examiner now makes an argument that “enterprise” is not a patentable distinction, and makes a series of unsupported statements, including that “it teaches that providing services in such an operating environment was already old and well known at the time of the invention disclosed in the prior art.” *Teper* teaches nothing of the sort.

The application as filed notes that common operating environments (COEs) are known, see paragraphs 0003-0004, but that they required, at the time of the invention, that all services be

charged to all users. The claimed invention allows for a COE which allows a la carte purchase of content and services, see paragraph 0015.

Nothing in Teper teaches or suggests that anything is “common” to the operating environments, but rather teaches that a user can receive a single bill for services purchased from different service provider sites. In an anticipation rejection, it is the Examiner’s burden to show that the claimed invention is identically taught by the cited reference. Examiner Levine was requested to show any teaching in Teper of any common operating environment, whether within a single enterprise or not. Examiner Levine could not meet his burden, and so the rejection is legally deficient.

Examiner Levine instead disclaims that his citations to the art are simply provided “for the convenience of the applicant”, and that other passages and figures may also apply. While applicant appreciates Examiner Levine’s courtesy, it is Examiner Levine’s burden under the law and MPEP to show where identical teachings can be found in the art, and Examiner Levine has not done so.

Further, each of the independent claims requires sending a list of available services to be displayed to a user, the list of available services including pricing information for at least some available services. Nothing in Teper teaches or suggests this feature. While Teper does mention that the “Online Broker site” may also have a “directory of services available”, nothing in Teper teaches or suggests that this directory includes pricing information, and nothing else in Teper teaches or suggests this limitation either. The Examiner appears to ignore this limitation, as it is not addressed at all in the Office Action.

In the Advisory Action, Examiner Levine argues that “charges” and “payments” are the same as the claimed price information. This is factually incorrect, of course. Further, the claims require sending a list of available services to be displayed to a user, the list of available services including pricing information for at least some available services – and any “charges” or “payments” in Teper are not provided with a list of available services, as required.

Finally, Examiner Levine argues that “pricing information” is “descriptive material and not functionally involved in the recited steps of the method”. Examiner Levine should be aware that the limitation at issue imposes a functional requirement on the claimed system, method, and computer program product, as this describes the content of information transmitted to be displayed to a user. The limitation also provides a distinct utility over prior art systems, as the claimed system enables the user to view available services and the corresponding pricing information before making a selection. It is clear that this is not merely “nonfunctional descriptive material” as discussed in *In re Gulak* and MPEP 2106, and Examiner Levine’s statements illustrated the legal and factual deficiency of the rejections.

The rejections of all claims therefore is legally deficient, in that specific elements of all independent claims are not taught or suggested by the art of record, and Examiner Levine has not met his burden of a *prima facie* anticipation rejection. Further, Examiner Levine’s incorrect assertions of “nonfunctional descriptive material” and that the limitation regarding “pricing information” sent with a list of services to be displayed to a user is met by Teper’s teaching of charges later appearing on a bill illustrates that the rejection is also factually deficient.

CONCLUSION


As a result of the foregoing, the Applicant asserts that the claims in the Application are in condition for allowance over all art of record, and respectfully requests this case be returned to the Examiner for allowance or, alternatively, further examination.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 05-0765

Respectfully submitted,

MUNCK BUTRUS, P.C.

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